

REMARKS

Claims 21 to 38 have been renumbered to claims 20 to 37, since these claims should have originally been numbered 20 to 37 (and not 21 to 38, as there was no claim 20). Also, claims 38 and 39 have been added, claims 27 and 28 (formerly claims 28 and 29) are canceled without prejudice, and therefore claims 20 to 26 and 29 to 39 (claims 20 to 37 were formerly claims 21 to 38) are now pending and being considered (since claims 1 to 19 were previously withdrawn in response to a restriction requirement).

Applicants respectfully requests reconsideration of the present application in view of this response.

Applicants thank the Examiner for acknowledging and considering the IDS paper, PTO-1449 form and the disclosed reference(s) filed on May 30, 2003.

With respect to paragraph one (1) of the Office Action, Figure 1 was objected to as not including designations 14 and 15. In fact, these boxes are present in Figure 1, but they were each mislabeled as box 1. Accordingly, Figure 1 has been corrected, as suggested, by labeling the box as 15 that includes boxes 13 and the other adjacent box 1, which has now been labeled box 14. Boxes 14 and 15 were mislabeled as box 1 in both cases. No new matter has been added. Approval and entry are respectfully requested, as is withdrawal of the drawing objection.

With respect to paragraph three (3), claims 21, 22, 27, 28 and 30 to 37 (now renumbered as claims 20, 21, 26, 27 and 29 to 36) were rejected under 35 U.S.C. 103(a) as unpatentable over Van Bosch, U.S. Patent No. 6,493,629.

The Office Action admits that the "Van Bosch" reference does not disclose a sensor for transmitting error code, nor a sensor that is coupled to the controller by a "vehicle bus". The Office Action asserts that this would have been obvious based on ordinary skill in the art, but offers no supporting evidence to establish this in the context of the claimed subject matter. In this regard, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning each of these assertions. This is because the rejections are apparently based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. In this way, the

U.S. Pat. Appl. Ser. No. 10/017,093
Att. Docket No. 11403/12
Reply To Office Action of 11/24/03

Applicants may have a fair opportunity to meaningfully and specifically address objective evidence -- as provided for by Rule 104.

The “Van Bosch” reference purportedly concerns a method for coupling location information from a vehicle, which includes the steps of :providing a WLAN communication device with a controller in the vehicle; detecting an emergency condition; and attempting to create a communication link with a portable WLAN enabled device. As characterized, a system for coupling location information from a vehicle includes: a WLAN communication device with a controller installed in a vehicle; a WLAN enabled device in communication with the WLAN enabled controller in the vehicle using a WLAN protocol in response to an emergency condition; a wireless communication network in communication with the WLAN enabled device; and a public safety answering point in communication with the wireless communication network. (See “Van Bosch”, Abstract).

While the obviousness rejections may not be agreed with, to facilitate matters, claims 20 and 33 (as renumbered, formerly claims 21 and 34) have been rewritten to better clarify their subject matter, and claims 27 and 28 (formerly claims 28 and 29) are canceled without prejudice.

Thus claim 20 (formerly claim 21) as presented is directed to a system for monitoring at least one apparatus in a vehicle including: *at least one sensor situated in the vehicle for sensing at least one error code of the at least one apparatus, the at least one sensor electrically being coupled to a vehicle bus*; a gateway node situated in the vehicle, the gateway node being electrically coupled to the vehicle bus, *the at least one sensor for communicating the at least one error code to the gateway node via the vehicle bus using a network protocol, the gateway node including a controller arrangement and a first wireless protocol arrangement, the first wireless protocol arrangement being coupled to the controller arrangement*; and a processor, *the gateway node communicating the at least one error code to the processor via a second wireless protocol arrangement that communicates with the first wireless protocol arrangement*, using a wireless communication protocol, in which *the at least one error code concerns diagnostics information and is accessible from the vehicle bus*.

As referred to in the present application, this system provides the benefit of providing

for a remote diagnostics system that obtains information from the vehicle bus:

In another embodiment, the sensor data is used in a diagnostic procedure to evaluate the vehicle systems. Sensor 11 may therefore also be any type of sensor evaluating another vehicle system or, alternatively, any system with self-diagnosing capabilities (i.e. any system capable of evaluating its own status). . . .

The status of sensor 11 might be communicated to the vehicle bus 12, where the controller 13 could read the status off the bus and communicate it to Bluetooth hardware 14 (or any other appropriate short-range wireless transmitter). Bluetooth hardware 14 might transmit the status code to remote Bluetooth hardware set 16 (or another short-range wireless transmitter). Remote Bluetooth hardware set might communicate the status code to processor 17, which might be a handheld computer running a diagnostic program. . . .

(Specification, pages 8 and 9).

Accordingly, and in view of the foregoing, the “van Bosch” reference does not disclose or suggest, in the context of the claimed subject matter, *the gateway node including a controller arrangement and a first wireless protocol arrangement, the first wireless protocol arrangement being coupled to the controller arrangement*, in which *the gateway node communicating the at least one error code to the processor via a second wireless protocol arrangement that communicates with the first wireless protocol arrangement*, and in which *the at least one error code concerns diagnostics information and is accessible from the vehicle bus*.

It is therefore respectfully submitted that claim 20 (formerly claim 21) is allowable, as are its dependent claims 21 to 26 and 29 to 32 (formerly claims 22 to 27 and 30 to 33).

With respect to paragraph four (4), claims 22 to 25, 28 and 37 (formerly claims 23 to 26, 29 and 38) were rejected under 35 U.S.C. 103(a) as unpatentable over “van Bosch” in view of Matsunaga, U.S. Patent No. 6,577,934.

Claims 22-25, 28 depend from claim 20 and claim 37 depends from claim 33, and are therefore allowable for the same reasons as their respective base claims, since any review of the secondary reference makes plain that it does not cure the critical deficiencies of the

U.S. Pat. Appl. Ser. No. 10/017,093
Att. Docket No. 11403/12
Reply To Office Action of 11/24/03

primary reference. Accordingly, these claims are allowable.

As further regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). It is respectfully submitted that the references even if combined would not solve the problems met by the presently claimed subject matter, as referred to herein.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), refer to when an Office Action’s assertions that it would have been obvious to modify the reference relied upon will not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that if the Office Action reflects a subjective “obvious to try” standard, it does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to

**make the modifications . . . necessary to arrive at the
claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). More recent still, in the case of *In re Lee*, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could

not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

. . . .

In its decision on Lee's patent application, the Board rejected the need for “any specific hint or suggestion in a particular reference” to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

[The] “common knowledge and common sense” on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. [The] Board's findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

In view of the foregoing, it is respectfully submitted that the claims rejected as obvious are in fact allowable.

New claims 38 and 39 do not include any new matter and are supported in the specification. New claims 38 and 39 depend from claim 33, and are therefore allowable for the same reasons as claim 33.

Accordingly, claims 20 to 26 and 29 to 39 are allowable.

U.S. Pat. Appl. Ser. No. 10/017,093
Att. Docket No. 11403/12
Reply To Office Action of 11/24/03

CONCLUSION

In view of the above, it is believed that the objection and the rejections have been obviated, and it is therefore respectfully submitted that claims 20 to 26 and 29 to 39 are allowable. It is therefore respectfully requested that the objection and rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
Dated: 2/18/2004 By: Richard L. Mayer
Richard L. Mayer
(Reg. No. 22,490)
KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200
33,865
Avaran C.
OK 11/24/04

CUSTOMER NO. 26646